

REMARKS

Claims 34-78 are pending in the present application. Claims 34-35, 46-54, 56-59, and 64-78 have been rejected. Claims 34-35, 46-54, and 56-59 have been canceled. Claims 39, 40, 42-45, 55, 60-63, and 77 have been amended. Claims 79, 80, and 81 have been added. No new matter has been introduced by these amendments or new claims. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

Allowed Claims

The Examiner is thanked for the allowance of Claims 39-45, 55, and 60-63. Claims 39, 55, and 60 have been rewritten into independent form. Allowance of these independent claims is respectfully requested.

The 35 U.S.C. §103(a) Rejections

Claims 34-35 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Aroyan et al. (U.S. Patent No. 6,163,313) in view of Kent et al. (U.S. Patent No. 6,492,979 B1). Applicants have canceled Claims 34 and 35 and therefore, this rejection is moot.

Claims 46-54 and 56-59 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Aroyan et al. (U.S. Patent No. 6,163,313), in view of Muroi (U.S. Patent No. 5,021,640). Applicants have canceled Claims 46-54 and 56-59, and therefore, this rejection is moot.

Claims 64-76 and 78 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Colgan et al. (U.S. Patent No. 6,483,498 B1). Applicants respectfully disagree with the Examiner's contentions.

Colgan et al. teaches a liquid crystal display including a first substrate having a first conductive layer formed thereon. A linearization pattern is formed on the first conductive layer for applying voltage gradients across the first conductive layer. A flexible polarizer is included having a second conductive layer formed thereon facing the first conductive layer across a gap formed therebetween, the polarizer providing a contact surface such that a touched position on the polarizer causes contact between the first conductive layer and the second conductive layer thereby identifying a location of the touched position. (Abstract) Colgan et al. teach a resistive touch sensor having a first conductive layer that faces a second conductive layer across a gap formed therebetween. (Col. 3, lines 1-10)

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The Colgan et al. reference does not disclose all the elements of the present invention. Claims 64, 68, 69, 73, and 78 recite either “a plurality of conductors disposed along at least one axis” or “a plurality of first conductors disposed along an X axis” and “a plurality of second conductors disposed along a Y axis”. [Emphasis added] Colgan et al. teach only a first conductive layer and a second conductive layer, not a plurality of conductors disposed along at least one axis.

Further, Colgan et al. do not disclose the combination of either a cathode ray tube having a glass envelope and a transparent touchpad of Claim 69, or a graphic underlay and a transparent touchpad as is claimed in Claim 78. Colgan et al. do not disclose all the elements of the present invention, and therefore, the Examiner has failed to make a *prima facie* case of obviousness.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). As stated above, Claims 64, 68, 69, 73, and 78 are non-obvious, therefore Claims 65-67, 70-72, and 74-76 are also non-obvious.

Reconsideration and withdrawal of this rejection is respectfully requested.

The 35 U.S.C. §102(e) Rejections

Claim 77 has been rejected under 35 U.S.C. § 102(e), as being anticipated by Harkin (U.S. Patent No. 6,327,376 B1). Applicants respectfully disagree with the Examiner's contentions.

Harkin teaches an electronic apparatus comprising a fingerprint sensing device (10) having an array of sensing elements (12) carried on a transparent substrate (35) for sensing capacitively the ridge pattern of a fingerprint placed over the array, in which the transparency of the device is utilized to provide additional capabilities. Thus, an optical sensing device (60) may be disposed beneath the device (10) to sense optically through the device a further biometric characteristic or the presence of the finger overlying the sensing element array. Substantial transparency can be afforded to the device by forming the sense electrodes (30) of the array from transparent conductive material. In products like mobile telephones, notebook computers, PDAs, smart cards or like portable electronic products of small size such as fingerprint sensing device can then advantageously be arranged overlying a display device with the display output being visible through the device. (Abstract)

The test for anticipation is symmetrical to the test for infringement and has been stated as: “That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Harkin does not teach disposing a transparent touchpad on a surface layer of a fingerprint sensor, as is claimed in amended Claim 77. The Examiner also contends that Harkin teaches that element 35 is a transparent touchpad. This is not possible because element 35 is an insulating substrate that the electrodes 30 are disposed onto form the capacitive fingerprint sensor. Therefore, a transparent touchpad could not be element 35 since it is a part of the fingerprint sensor. Amended Claim 77 recites that a transparent touchpad is disposed on the surface of the fingerprint sensor. As the Examiner contends, the formation of what is claimed in amended Claim 77 is not possible. The Harkin reference does not teach each and every element of the present application. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

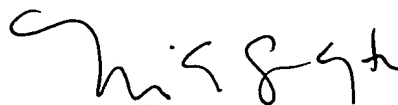
The Cited Prior Art

The prior art cited (U.S. Patent No. 6,492,979 to Kent et al.) and not relied upon is believed to comprise general information that does not render the present application anticipated or obvious.

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

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A handwritten signature in black ink, appearing to read "Nicole E. Coppes-Gathy".

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